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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,183	09/19/2001	Stephen Chen	BHT-3204-4	9418
7590 05/26/2004				
DOUGHERTY & TROXELL 5205 LEESBURG PIKE, SUITE 1404 FALLS CHURCH, VA 22041		EXAMINER RAMAKRISHNAIAH, MELUR		
		ART UNIT		PAPER NUMBER
		2643		2
DATE MAILED: 05/26/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/955,183

Applicant(s)

CHEN, STEPHEN

Examiner

Melur Ramakrishnaiah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 is rejected under 35 U.S.C 102(e) as being anticipated by Kraft (US PAT: 6,411,822 B1, filed 8-25-1999).

Regarding claim 1, Kraft discloses a telephone dialing apparatus capable of directly downloading telephone directory from a mobile phone subscriber module (SIM) card comprising a SIM card socket, a SIM card reader, a control unit, a memory unit, a dialing unit, a human-machine interface, an alarm unit, and an information editing unit, wherein: the SIM card socket in (1, fig. 1) is to couple the mobile phone SIM card and to allow the SIM card reader (not shown) to read data stored in the mobile phone SIM card, the SIM card reader includes communication protocols of the mobile phone SIM card and through the SIM card socket to read data stored in the mobile phone SIM card, and to store temporarily in the memory unit (17, col. 6 lines 65-67, col. 6 lines 1-18 and fig. 7), the control unit (18, fig. 2) is activated by the human-machine interface (2, figs. 1-2) and control the operations of the other units of the apparatus (col. 4 lines 42-44), the memory unit (17, fig. 2) temporarily stores data including telephone numbers, names and brief codes (see fig. 4), the dialing unit outputs dialing signals to replace human

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dialing operations of pressing push buttons (col. 7 lines 31-37), the human-machine interface is selectively a matrix array of pushbuttons, a dial plate, or a touch screen to allow users to activate apparatus of the invention (col. 3 lines 66-67, col. 4 lines 1-10), the alarm unit (reads on 3, figs. 2-3, 4) allows users to view and inspect conditions of the apparatus and search electronic telephone directory, and generate alarm in the form of visual display or audio sound (col. 7 lines 15-22), and information editing unit allows users or system edit the received telephone information in the electronic telephone directory (col. 8 lines 3-31), whereby users do not need to enter the electronic telephone directory repeatedly and more than one telephone system are allowed to utilize the mobile phone electronic telephone directory to perform dialing operations ( col. 2 lines 21-29).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Courtis et al. (JP411103338A, hereinafter Courtis).

Regarding claim 2, Kraft does not teach the following: apparatus is linked to an earphone circuit.

However, Courtis discloses wireless telephone, which teaches the following:  
apparatus is linked to an earphone circuit (fig. 2, see abstract)

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kraft's system to provide for the following: apparatus is linked to an earphone circuit as this arrangement would provide an improved user interface for user to initiate telephone dialing as taught by Courtis.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Stanley et al. (US PAT: 4,266,102, hereinafter Stanley).

Regarding claim 3, Kraft does not teach the following: apparatus is linked to a fixed line telephone.


However, Stanley discloses automatic dialing device which teaches the following:  
apparatus is linked to a fixed line telephone (fig. 1, col. 2 lines 8-15).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Kraft's system to provide for the following: apparatus is linked to a fixed line telephone as this arrangement would facilitate automatic dialing when used with a regular telephone as taught by Stanley.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on M-F 6:30-4:00; every other F Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703)305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Melur Ramakrishnaiah  
Primary Examiner  
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